UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/502,082	07/22/2004	Nils Cornelis Sips	7393/84061	8981

42798 7590 12/07/2010

FITCH, EVEN, TABIN & FLANNERY
P. O. BOX 18415
WASHINGTON, DC 20036

EXAMINER	
STULII, VERA	

ART UNIT	PAPER NUMBER
1781	

MAIL DATE	DELIVERY MODE
12/07/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/502,082	SIPS ET AL.	
	Examiner	Art Unit	
	VERA STULII	1781	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 July 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,9,16-18 and 21-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,9,16-18 and 21-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application.
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/16/2010 has been entered.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-7, 9, 16-18 and 21-27 are rejected under 35 U.S.C. 103(a) as being obvious over Kettlitz et al in view of Mori et al (JP 57186465)

In regard to claims 1, 7 and 24, Kettlitz et al disclose heat stable high viscosity starches (Abstract). Further in this regard Kettlitz et al disclose that "the starches of the present invention are obtained by reacting high viscosity starch with activated chlorine under alkaline conditions" and "[t]he starches of the present invention are used to replace viscosity stable starches obtained by conventional chemical cross-bonding" (Col. 1 lines 3-8). Kettlitz et al disclose that high viscosity starches are starches which show an important increase in viscosity characteristics upon heating, starches with a high swelling power are those derived from waxy varieties and starches derived from tubers and roots (e.g. potato, tapioca) (Col. 1 lines 20-26). Kettlitz et al disclose that the swollen

granules burst to a large extent during heating which leads again to a drastic viscosity breakdown. Kettlitz et al disclose that in order to overcome the undesirable viscosity breakdown starches may be stabilized (Col. 1 lines 20-26). The viscosity breakdown can be overcome by treating the starch granules with chemical reagents (Col. 1 lines 28-30). Kettlitz et al disclose that highly swollen (viscous) cooking stable starches are used in many different applications, for example in the preparation of soups, sauces, meat products, dressings, micro-wavable food and in the preparation of bakery creams and fillings, in convenience foods that need to have a high viscosity and smooth texture after heating (to 80-100ºC) (Col. 1 lines 46-50). Kettlitz et al disclose that stabilized high viscosity starches are particularly suitable for the mentioned applications (Col. 1 lines 51-53). Kettlitz et al disclose that highly swollen (viscous) cooking stable starches are used in many different applications, for example in the preparation of soups, sauces, meat products, dressings, micro-wavable food and in the preparation of bakery creams and fillings, in convenience foods that need to have a high viscosity and smooth texture after heating (to 80-100ºC) (Col. 1 lines 46-50). Kettlitz et al disclose use of stabilized starch n-alkenyl succinate in the food products that normally undergo UHT/high-temperature/sterilization/ pasteurization treatment and reheated for further consumption (soups, sauces, meat products, dressings, micro-wavable food, creams and fillings).

In regard to claims1, 3, 7, 9, 16, 17, 22 and 25, Kettlitz et al disclose stabilized starch n-alkenyl succinate (Col. 2 lines 55-56).

In regard to claims 3, 9 and 16, Kettlitz et al disclose stabilized starch n-octenyl succinate (Col. 2 lines 56-57).

In regard to claim 4, Kettlitz et al disclose that all starches can be used to prepare the stabilized starch n-octenyl succinate (Col. 3 lines 46-48).

In regard to claims 6 and 7, Kettlitz et al disclose soups, sauces, meat products, dressings, micro-wavable food, bakery creams and fillings (Col. 1 lines 46-50).

Kettlitz et al do not specifically disclose UHT treatment of the food products. However, Kettlitz et al disclose use of stabilized starch n-alkenyl succinate in the food products that normally undergo UHT/high-temperature/sterilization/ pasteurization treatment.

Mori et al discloses preparation of an aseptic sauce product by subjecting the sauce to the ultra-high temperature pasteurization (Abstract). Mori et al further discloses that sauce contains fat, oil starch, etc (Abstract). Mori et al further discloses time and temperature conditions for the UHT sterilization (130-150°C for several seconds) (Abstract). Thus, Mori et al is relied upon as an evidence of subjecting a starch-based sauce product to an UHT treatment in order to obtain aseptic product (free from pathogenic microorganisms). Therefore, it would have been obvious to modify Kettlitz et al and to subject food products disclosed by Kettlitz to the UHT treatment as disclosed by Mori et al in order to obtain aseptic food products free from pathogenic microorganisms. It would have been obvious to modify Kettlitz et al and to subject food products

disclosed by Kettlitz to the UHT treatment as disclosed by Mori et al in order to increase the shelf life and microbial stability of food products.

Regarding particular viscosity recitations after re-heating in claims 1, 2, 5, 7 and 21, 22, 23, 24, 26 and 27, it is noted that all these recitations intend to show that viscosity is increased after reheating comparing to the initial viscosity of the food product which has undergone UHT treatment. Further in this regard, it is noted that Kettlitz et al teach stabilized starch n-alkenyl succinate as disclosed in instant specification. As stated by Applicants in the specification "[for] obtaining the stabilized starch n-alkenyl succinate, the starch n-alkenyl succinate can be treated with active chlorine and can be prepared according to the process described in EP 0811633". Thus, Applicants admit that the starches used in the present inventions can be prepared according to the process described in EP 0811633. It is further noted that EP 0811633 was also published as US 6,235,894, which is used as a main reference in the instant rejection. Therefore, it is not seen how the food products containing stabilized starch n-alkenyl succinate disclosed by Kettlitz '894 are different from the presently claimed food products, when in fact, Kettlitz '894 disclose the same stabilized starch n-alkenyl succinate as claimed by Applicants. The increase in the viscosity after the re-heating is seen to have been an inherent property of the stabilized starch n-alkenyl succinate. The food products disclosed by Kettlitz et al (soups, sauces, meat products, micro-wavable food, bakery creams and fillings) are generally intended to be re-heated prior to consumption when the food product is served hot. The fact that applicant has recognized another advantage which would flow

naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Further in this regard, although the references do not specifically disclose every possible quantification or characteristic of its product, such as viscosity after re-heating, this characteristic would have been expected to be in the claimed range absent any clear and convincing evidence and/or arguments to the contrary. The combination of references disclose the same starting materials and methods as instantly (both broadly and more specifically) claimed, and thus one of the ordinary skill in the art would recognize that the viscosity after re-heating, among many other characteristics of the product obtained by referenced method, would have been an inherent result of the process disclosed therein. The Patent Office does not possess the facilities to make and test the referenced method and product obtain by such method, and as reasonable reading of the teachings of the references has been applied to establish the case of obviousness, the burden thus shifts to applicant to demonstrate otherwise.

Further in regard to claim 22 and limitation of UHT treatment and re-heating, it is noted that instant claims recite the product, not the process. The limitations of claim 22 and limitations of UHT treatment and re-heating are related to the process. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a

product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (see MPEP 2113).). Therefore, the method steps included in the product claims would not impart any patentable distinction.

Kettlitz is also silent as to the amount of stabilized starch n-alkenyl succinate recited in claims 17 and 25 and the initial viscosity of the UHT treated product, recited in claim 18 and 24. One of ordinary skill in the art would have been motivated use the stabilized starch n-alkenyl succinate in the amount according to the desired level of viscosity of the food product. One of ordinary skill in the art would have been motivated to vary the amount of the stabilized starch n-alkenyl succinate depending on the desired organoleptic profile of the specific food products (soups, sauces, meat products, dressings, micro-wavable food, creams and fillings). The amounts of the stabilized starch n-alkenyl succinate are seen to have been a result effective variable.

Response to Arguments

Applicant's arguments filed 07/16/2010 have been fully considered but they are not persuasive.

Applicant's arguments regarding Daenzer-Alloncle et al have been considered but are moot in view of the new ground(s) of rejection.

In response to Applicants arguments regarding UHT treatment, it is noted that instant claims recite the product, not the process. The limitations of UHT treatment and re-heating are related to the process. "[E]ven though product-by-

process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (see MPEP 2113).). Therefore, the method steps included in the product claims would not impart any patentable distinction.

In response to applicants' argument regarding the viscosity increase, it is noted that Kettlitz et al teach stabilized starch n-alkenyl succinate as disclosed in instant specification. As stated by Applicants in the specification "[for] obtaining the stabilized starch n-alkenyl succinate, the starch n-alkenyl succinate can be treated with active chlorine and can be prepared according to the process described in EP 0811633". Thus Applicants admit that the starches used in the present inventions can be prepared according to the process described in EP 0811633. It is further noted that EP 0811633 was also published as US 6,235,894, which is used as a main reference in the instant rejection. Therefore, it is not seen how the food products containing stabilized starch n-alkenyl succinate disclosed by Kettlitz '894 are different from the presently claimed food products, when in fact, Kettlitz '894 disclose the same stabilized starch n-alkenyl succinate as claimed by Applicants. The increase in the viscosity after the re-heating is seen to have been an inherent property of the stabilized starch n-alkenyl succinate. The food products disclosed by Kettlitz et al (soups, sauces,

meat products, micro-wavable food, bakery creams and fillings) are generally intended to be re-heated prior to consumption when the food product is served hot. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Further in this regard, although the references do not specifically disclose every possible quantification or characteristic of its product, such as viscosity after re-heating, this characteristic would have been expected to be in the claimed range absent any clear and convincing evidence and/or arguments to the contrary. The combination of references disclose the same starting materials and methods as instantly (both broadly and more specifically) claimed, and thus one of the ordinary skill in the art would recognize that the viscosity after re-heating, among many other characteristics of the product obtained by referenced method, would have been an inherent result of the process disclosed therein. The Patent Office does not possess the facilities to make and test the referenced method and product obtain by such method, and as reasonable reading of the teachings of the references has been applied to establish the case of obviousness, the burden thus shifts to applicant to demonstrate otherwise.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VERA STULII whose telephone number is (571)272-3221. The examiner can normally be reached on 7:00 am-3:30 pm, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vera Stulii/
Examiner, Art Unit 1781